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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,914	12/28/2001	Yoshihide Murakami	Q67950	2679
7590 10/03/2003				
SUGHRUE MION, PLLC 2100 Pennsylvania Avenue, NW Washington, DC 20037-3213			EXAMINER CHANG, VICTOR S	
			ART UNIT 1771	PAPER NUMBER
DATE MAILED: 10/03/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,914

Applicant(s)

MURAKAMI ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner has carefully considered Applicants' remarks filed on 8/11/2003.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' argument that "the modifier of the present invention can be selected from a group consisting of a hydrophilic polymer and inorganic fine particles" (Remarks, pages 2-3, bridging paragraph) is persuasive. As such, the rejection of section 2 of Paper No. 5 is withdrawn.

Response to Amendment

4. Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-7 of prior U.S. Patent No. 6372339. This is a double patenting rejection, substantially for the reasons set forth in section 4 of Paper No. 5, together with the following additional observations.

Applicant's Response arguing that the "comprising" language of claim 1 of the present application would allow for inclusion of many other substances ... the claim is much broader than claim 4 of the parent patent and thus does not claim identical subject matter (Remarks, page 4, third paragraph) is not persuasive, the Examiner notes that both claim 4 and its dependent upon claim 1 of parent patent are

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"comprising" claims, as such claim 1 of the present invention pertains to the same subject matter as claim 4 of the parent patent.

5. Claims 3, 8-9 and 17-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-4, 10-11 and 18-19 of U.S. Patent No. 6372339. This is a double patenting rejection, substantially for the reasons set forth in section 6 of Paper No. 5, together with the following additional observations.

With respect to Applicants' argument that during the prosecution of the parent patent, Species A is set as hydrophilic polymer, and "The Examiner is not saying and it is not correct even suggest that species A includes more than the hydrophilic polymer, that is, it includes other specifics of the subject matter of claims 4-7 in addition to the recitation of the hydrophilic polymer" (Remarks, pages 5-6, bridging paragraph), the Examiner notes that while species are preferably identified as the species of figures or examples, if the species cannot be conveniently identified, the claims may be grouped in accordance with the species to which they are restricted (MPEP § 809.02(a)). It is noted that in the restriction requirement of the Office action dated July 10, 2001 of the parent application, the Examiner expressly stated that "species A comprising the hydrophilic polymer of claims 4-7", and the originally submitted claims 4 and 6 clearly recite "hydrophilic polymer is polyvinyl pyrrolidone", and the originally submitted claims 5 and 7 recite "hydrophilic polymer is contained in a weight proportion of hydrophilic polymer:elastomer resin = 2.98 to 40:60". As such, claims 3, 8-9 and 17-18 of the instant invention are clearly not consonant in scope with the previously restricted

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species A of the hydrophilic polymers of claims 4-7 of U.S. Application No. 09/417114, because none of the claims 3, 8-9 and 17-18 of instant invention recites any of previously restricted elements (see underlines), and the Examiner asserts that double patenting rejection is appropriate, Applicants' argument to the contrary notwithstanding.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1900-
1700

Daniel Zinker